

Exhibit C

1
2 IN THE UNITED STATES DISTRICT COURT
3 FOR THE DISTRICT OF DELAWARE
4 Case No. 03-1153-GMS

ORIGINAL

5 -----x
6 HONEYWELL INTERNATIONAL, INC. and
7 HONEYWELL INTELLECTUAL PROPERTIES, INC.,
8 Plaintiffs,

9 - against -

10
11 HAMILTON SUNDSTRAND CORPORATION,
12 Defendant.

13 -----x
14 January 26, 2006
15 9:01 a.m.

16 Videotaped Deposition of MELVIN
17 GARNER, taken by Defendant, pursuant to
18 Notice, held at the offices of Kirkland &
19 Ellis, LLP, 153 East 53rd Street, New
20 York, New York, before Todd DeSimone, a
21 Registered Professional Reporter and
22 Notary Public of the State of New York.
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1 GARNER

2 Q. How many depositions have you
3 taken?

4 A. Probably over a hundred.

5 Q. When was the last time you took
6 a deposition?

7 A. Probably a year ago.

8 Q. As a lawyer, do you have a duty
9 to be an advocate of your client's
10 position?

11 A. When I'm representing a client
12 as a lawyer, yes.

13 Q. Is Honeywell your client?

14 A. Yes, I have been retained by
15 Honeywell as an expert witness in this
16 case.

17 Q. Are you a patent lawyer?

18 A. Yes, I am.

19 Q. Do you consider yourself to be
20 an expert in the patent law?

21 A. I consider myself an expert and
22 I'm here testifying as an expert in the
23 operations of the Patent Office, the way
24 patent attorneys deal with the Patent
25 Office, and to help the court, to the

1 GARNER

2 extent I can, in interpreting the file
3 history of the cases involved in this
4 litigation.

5 Q. Are you also an expert in
6 patent law?

7 MS. STEVENSON: Objection.
8 Asked and answered.

9 A. I'm not here testifying as an
10 expert in patent law. The judge will
11 determine what the law is.

12 Q. Am I right that you are also a
13 litigator?

14 A. Yes, I have litigated.

15 Q. And you've been lead counsel in
16 approximately 30 litigations?

17 A. Yes, that's correct.

18 Q. And in that role you are acting
19 as an advocate on your client's behalf?

20 A. That's right.

21 Q. Am I right that you haven't
22 been employed as an electrical engineer in
23 over 30 years?

24 A. That's probably accurate.

25 Q. Do you have any -- well, what

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was your last full-time employment as an
engineer?

A. As an engineer it was with a
company called Sequential Information
Systems.

Q. When did that end?

A. Just before I went to Bell
Labs. So it probably ended in 1971.

THE VIDEOGRAPHER: Excuse me,
Counsel, can we go off the record? I'm
experiencing technical difficulties.

MR. LIND: Okay.

THE VIDEOGRAPHER: The time is
9:05 a.m. We are going off the record.

(Recess taken.)

THE VIDEOGRAPHER: The time is
9:07 a.m. We are back on the record.

BY MR. LIND:

Q. Sir, you don't have any
experience working with control systems
for compressors on gas turbine engines,
correct?

A. That's correct.

Q. Has any of your work experience

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involved gas turbine engines?

A. No.

Q. How about has any of your work experience involved compressors?

A. By "work experience," do you mean my work experience as an engineer or as a patent attorney?

Q. Let's start with engineering. Has any of your work experience as an engineer involved work with compressors?

A. No.

Q. Has any of your work experience as an engineer involved work with diffusers?

A. Could you repeat the question?

Q. Has any of your work as an engineer in your life involved working with diffusers?

A. No.

Q. Has any of your work involved work with surge control systems?

A. That is as an engineer?

Q. As an engineer.

A. No.

GARNER

Q. Has any of your work as a patent attorney involved working with surge control systems?

A. Except for this case, no.

Q. Has any of your work as a patent attorney involved working on diffusers on compressors?

A. I'm not sure about diffusers on compressors. Potentially I have worked on that as a patent attorney.

Q. What matter?

A. I have a client who makes refrigeration equipment. I have either prosecuted or supervised the prosecution of a number of patent applications related to their refrigeration technology, which includes compressors and various parts. Whether or not a diffuser was one of those parts, I'm not clear. I don't recall.

Q. You don't recall any prior work as a patent attorney working with diffusers, correct?

A. That's correct.

Q. Did you ever take any courses

1 GARNER

2 A. That's right.

3 Q. Do you understand the things
4 shown in Figure 4 of the '893 patent to be
5 the electrical control circuitry that is
6 part of the dispute or the equivalents
7 dispute in this remand proceeding?

8 A. Again, I haven't prepared nor
9 is it my responsibility to figure out what
10 the dispute is. So to that extent I can't
11 answer. I do know that the diagram on
12 Figure 4 shows the way that the control
13 system -- shows part of the operation of
14 the control system. It is my
15 understanding that that is part of the
16 dispute.

17 Q. As to compressors and
18 diffusers, you are not a person of
19 ordinary skill in the art though, correct?

20 A. That's correct.

21 Q. Have you ever seen -- your
22 specialty in your resume, you talked about
23 having a specialty in video circuits,
24 cellular telephones, medical products,
25 office products, and computer hardware and

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2 Attachment A.

3 Q. If you turn to page 5 of your
4 resume at Attachment A of Exhibit 48, in
5 the first full paragraph it says
6 "Mr. Garner has also appeared as an expert
7 witness in key trials throughout the
8 United States."

9 What do you mean by "key
10 trials"?

11 A. They are the same -- the trials
12 that are referred to in the expert report
13 itself. I believe I can find the
14 paragraph for you. Paragraph 9.

15 Q. Why did you consider the trials
16 in paragraph 9 of your expert report to be
17 key trials?

18 A. They were interesting,
19 especially the U.S. Surgical one is
20 frequently cited for various propositions.

21 Q. So you associate "key" with
22 interesting?

23 A. Yes.

24 Q. Have you ever worked at the
25 United States Patent and Trademark Office?

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A. I have not.

Q. Have you ever been a patent examiner?

A. No, I have not.

Q. Therefore, you've never been a chief patent examiner either, right?

A. That's true.

Q. Have you ever been a judge on the Board of Patent Appeals?

A. No, I have not.

Q. Is your compensation -- you are getting paid \$625 an hour for your work in testifying here; is that right?

A. Yes, for my work in studying the files as well as for today's work.

Q. If you were to testify at trial, would that rate be the same or do you have a higher rate for testifying at trial?

A. It is the same.

Q. I'm going to show you what I've marked as Exhibit 49.

(Hamilton Remand Exhibit 49 marked for identification.)

1 GARNER

2 number of years?

3 A. I'm here to offer my opinion
4 about what I believe reasonable patent
5 attorneys have done and would do under
6 certain circumstances in practicing before
7 the Patent Office.

8 Q. And that is based on your role
9 as a lawyer practicing before the Patent
10 Office for a number of years, correct?

11 MS. STEVENSON: Objection,
12 vague.

13 A. It is based on my experience as
14 a lawyer practicing before the Patent
15 Office, as well as my experience in
16 teaching courses on the subject, also my
17 experience in working with others within
18 my firm and other firms and in bar
19 associations dealing with the same issues.

20 Q. Do you agree that in your
21 experience in prosecuting patents the file
22 histories or prosecution histories for the
23 two patents in suit are relatively
24 uncomplicated?

25 MS. STEVENSON: Objection,

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vague.

A. Yes.

Q. And they are some of the shorter file histories I guess that you might have dealt with over the years, correct?

A. I've had shorter, but they are certainly not extensive file histories.

Q. And there were only a few Office actions, maybe only one in the case of one of the patents; is that right?

A. Yes.

Q. Often patents when they go through prosecution can have, you've heard the term tortuous file histories with lots of Office actions and lots of back and forth between the Patent Office and the examiner, correct?

A. That is certainly possible.

Q. Can you name for me all of the cases for which you've ever prepared an expert report?

A. I probably can't do that, but I can give you -- in the three cases that

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2 interest to me. Also -- well, I can't
3 think of any additional things that we
4 talked about during that first call.

5 Q. When Honeywell hired you, what
6 did you understand your assignment to be
7 in this case?

8 A. To review the file history and
9 to see whether or not there was any
10 information within the file history and
11 some selected pleadings that I was given
12 which would support an argument for
13 overcoming the presumption on the three
14 bases that you mentioned earlier.

15 Q. How long did it take you to
16 review the file histories for these two
17 patents?

18 A. I really don't know because I
19 didn't do them -- you know, I have other
20 work and I didn't like set aside several
21 days and just do this. So I would read a
22 little bit and put it aside and do
23 something else. So it was over the course
24 of maybe a week or so.

25 Q. But just to review the file

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2 you, that would have been submitted after
3 your report.

4 A. No. He is the technical expert
5 for Hamilton?

6 Q. That's correct.

7 A. No, I haven't.

8 Q. Did you review any depositions
9 in this case in coming to your opinions?

10 A. Unless they are listed here, I
11 haven't.

12 Q. Just to confirm, there are no
13 depositions listed in your list of
14 materials reviewed, correct?

15 A. Yes.

16 Q. Did you talk to anyone other
17 than Honeywell's lawyers in coming to the
18 opinions that you intend to offer in this
19 case?

20 A. No.

21 Q. Did you talk to anyone at
22 Honeywell in forming your opinions in this
23 case other than their outside counsel?

24 A. No.

25 Q. And you didn't talk to, for

1 GARNER

2 Q. Have you done any work for
3 Honeywell prior to this case?

4 A. Yes.

5 Q. What work had you done for
6 Honeywell?

7 A. Going back maybe ten years,
8 there was a company called Allied Signal,
9 and I think we prosecuted four or five
10 patent applications for Allied Signal. I
11 guess towards the end of that prosecution
12 it was acquired by Honeywell. So for a
13 short period of time Honeywell was the
14 client.

15 Q. Back to people you talked to.
16 Am I right that you didn't talk
17 to any what you would call persons of
18 ordinary skill in the art of compressors
19 and diffusers in coming to the opinions
20 that you came to in this case, right?

21 A. That's correct.

22 Q. Do you know Mr. Goolkasian?

23 A. No.

24 Q. He is an expert that Hamilton
25 Sundstrand has submitted a report from; do

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2 equivalent having to do with inlet guide
3 vanes.

4 Q. Is it your position that the
5 Festo estoppel does not apply here because
6 there was no prior art disclosing the use
7 of inlet guide vane positions cited by the
8 examiner?

9 MS. STEVENSON: Objection.
10 Asked and answered.

11 A. Or anything equivalent to it.
12 It just wasn't an issue, which is why it
13 is tangential.

14 Q. When you say it wasn't an
15 issue, you are talking about inlet guide
16 vanes?

17 A. Inlet guide vanes used to
18 control the equipment. In the Chimie
19 case, dust and dust-free was an issue.
20 Maybe it wasn't an issue with respect to
21 this particular equivalent, but that
22 feature was certainly an issue.

23 Q. Is it your position that the
24 Festo estoppel does not apply here because
25 there was no prior art cited by the

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examiner that disclosed the use of inlet
guide vane position in any way in a surge
control system?

A. Yes, that it or anything else
equivalent to that, and not only as cited
by the examiner, as cited by the applicant
or as contained in the application itself.

Q. And you limited your review to
the file wrapper, the prosecution history
for such prior art, correct?

A. I believe that's the proper way
to do it, yes.

Q. Is it your opinion that the
scope of Honeywell's surrender of subject
matter is limited to what was necessary to
avoid the prior art that was the basis of
the examiner's rejection?

A. If I understand your question
right, the answer is no.

Q. What didn't you maybe
understand about my question, you think?

A. I thought you were saying that
the estoppel was limited to the change in
the claim. And the change in the claim

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presumption, and then you have to do something else to overcome the presumption.

Q. Did you make any assumptions in forming your opinions in this case?

MS. STEVENSON: Objection, vague.

A. Yes.

Q. What assumptions did you make?

A. Wherever in the opinion I say "I have been informed" or "I understand," I'm assuming that I'm correct as opposed to something based on what I personally know.

Q. And anytime you say "I understand" or "I have been informed," we know that that information or understanding comes from Honeywell's legal team, right?

A. Potentially -- probably most likely comes from Honeywell's legal team. It might also come from an understanding that I have of the law. But because I'm not here as a patent expert, I can just

GARNER

say that it is my understanding that this is what the law is, and obviously the judge in the case is going to tell everybody what it really is.

Q. Because you are not purporting to be any better than Judge Sleet at testifying or talking about what the law is, correct?

A. I'm conceding myself being significantly less capable than the judge.

Q. What opinions do you have that depend on any of the assumptions that you made?

A. The foreseeability -- I should turn to my report. The foreseeability reason for overcoming the presumption of relinquishing subject matter is based on the fact that, at least in the context of controlling these units, use of the IGV valve is after-developed technology and so therefore it was not foreseeable. That's based on my reading of the record. In real life it may not be true.

But I believe that the courts

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2 instruct you to look to the file history
3 to make these kind of determinations,
4 because the Federal Circuit's primary
5 issue was to allow the public to be able
6 to know the metes and bounds of the
7 patent, and therefore they wanted you to
8 rely on the file history to be able to
9 tell, as opposed to, say, testimony from
10 the patent attorney or some other
11 extrinsic information.

12 Q. So your understanding is that
13 the foreseeability analysis under Festo is
14 limited by I think you called it the metes
15 and bounds of what was in the file
16 history, correct?

17 A. That's my understanding.

18 Q. And when you said that -- you
19 made an assumption that IGV -- use of IGV
20 position was, quote, "after-developed
21 technology," that was an assumption that
22 you made based on your understanding of
23 the file history, correct?

24 A. Yes.

25 Q. And you did not go look outside

1 GARNER

2 the file history, correct?

3 A. That's right.

4 Q. Are there any other opinions
5 that depended on assumptions that you
6 made?

7 A. I assumed that the description
8 of the Sundstrand lockout feature was as
9 described in the materials presented to
10 me. I've got no independent information
11 about it.

12 Q. You have no understanding of
13 how the APS 3200 so-called lockout feature
14 works based on study of technical
15 documents or discussions with people,
16 etc., right?

17 A. That's correct.

18 Q. When you say you relied on how
19 the working of this so-called lockout
20 feature was expressed in some of the
21 documents you looked at, are you talking
22 about Honeywell's expert reports?

23 A. Actually, the expert reports of
24 both Honeywell and -- I'm sorry, not
25 expert reports -- yes, the older expert

1 GARNER

2 Q. Well, Honeywell could have
3 fought that, right?

4 A. Unsuccessfully. It is a matter
5 of discretion.

6 Q. But there is an appeal process
7 that you can go through in order to
8 challenge a ruling like that by an
9 examiner, correct?

10 A. It is a petition process.

11 Q. Instead of appealing the
12 examiner's decision, Honeywell chose to
13 agree and split the method claims and the
14 apparatus claims into two separate
15 patents, correct?

16 A. Well, the examiner split them
17 and they went along with it. They didn't
18 petition the examiner's decision.

19 Q. So I understand how this works,
20 is that a prosecution formality rather
21 than any intent by Honeywell that the
22 method claims and the apparatus claims
23 should be contained in two separate
24 patents?

25 MS. STEVENSON: Objection.

1 GARNER

2 Lacks foundation.

3 A. It is a prosecution formality.

4 The fact that they filed them together
5 shows that they would like to have had
6 them together. The examiner is the one
7 that made them split it into two.

8 It increases the costs to the
9 company to have two separate patents,
10 because now you have to pay maintenance
11 fees on two cases and you have to track
12 two cases and stuff like that. But
13 because it is a discretionary thing, you
14 can't -- not you can't -- but you almost
15 never win if you challenge it. So patent
16 attorneys have come to believe that once
17 you've gotten one of these kinds of
18 rejections, because there is no loss of
19 coverage, that you just go along with it.

20 Q. You go ahead and split them up
21 in order to avoid the headache, so to
22 speak?

23 A. The likelihood that you won't
24 be successful in contesting it, so you
25 might as well go ahead and do what the

1 GARNER

2 lockout feature.

3 In fact, part of my report says
4 that, I believe, you could make a very
5 legitimate argument that the claims that
6 exist would be directly infringed. I
7 realize that the court has ruled that that
8 is not true, that there is no direct
9 infringement. But I don't believe that a
10 reasonable attorney at the time wouldn't
11 be fairly comfortable in taking the
12 position that it is.

13 Q. Is Honeywell represented by
14 reasonable attorneys?

15 MS. STEVENSON: I object to the
16 form.

17 A. Yes.

18 Q. Do you understand, I think as
19 you put it, the court has ruled that there
20 was no literal infringement by Sundstrand
21 of the asserted patent claims?

22 A. Yes.

23 Q. And you understand that the
24 jury determined that there was no literal
25 infringement by Sundstrand of the

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2 think you called it after-developed
3 technology?

4 A. After-arising. Essentially
5 some technology that came into existence
6 after the prosecution.

7 Q. Is it your opinion that the
8 need to redraft the asserted claims in
9 such a way that they would literally cover
10 the Sundstrand equivalent was not
11 foreseeable to a patent attorney in 1982
12 because a reasonable patent attorney
13 wouldn't have known how the court was
14 going to come out in the Festo cases?

15 A. No.

16 Q. You say in paragraph 43 of your
17 report, on page 13, that "reasonable
18 patent attorneys during that period," and
19 I think you are referring to 1982-'83,
20 correct?

21 A. Yes.

22 Q. You say "Reasonable patent
23 attorneys in 1982-83 would have presumed
24 that any amendment to the claims to avoid
25 prior art would have resulted in an

1 GARNER

2 estoppel giving up equivalents in the
3 range between the original scope and the
4 literal language of the amended claim,
5 only to the extent necessary to avoid the
6 prior art in under consideration by the
7 applicant and the examiner."

8 Do you see that?

9 A. Yes.

10 Q. That's your opinion, correct?

11 A. Yes.

12 Q. Is your opinion on the
13 foreseeability issue based on your belief
14 that reasonable patent attorneys in 1982
15 or '83 would have thought that they were
16 only giving up scope to the extent
17 necessary to avoid the prior art under
18 consideration by the applicant and the
19 examiner?

20 A. You mean my current opinion?

21 Q. Correct.

22 A. No.

23 Q. Is the basis for your current
24 opinion on foreseeability your belief that
25 back in 1982 or '83 reasonable patent

1 GARNER

2 thought about it. But more specifically
3 in this case there was nothing related to
4 IGV that would have caused you to think
5 about it.

6 Q. Can you tell me any case
7 opinions that say that the mindset of a
8 patent attorney back at the time of the
9 amendment is relevant to the Festo
10 analysis?

11 A. There is not specific language.
12 But what the court says is that
13 essentially there is a presumption and you
14 are entitled to go back and figure out
15 whether or not it is reasonable -- whether
16 or not the presumption is reasonable under
17 the circumstances.

18 So part of the value that I
19 hope I can bring to the court is that I
20 was prosecuting patents back during that
21 time period. I would have looked at this
22 file history. So can I divine what the
23 intent was, was there really an intent to
24 give up claim coverage or was there some
25 other intent.

1 GARNER

2 Q. Are you relying on Judge
3 Newman's dissent in Festo as part of your
4 opinions in this case?

5 A. No, I'm not.

6 Q. Is it your opinion that the
7 equivalent must not have been foreseeable
8 because it was not cited in any of the art
9 in the prosecution history?

10 A. No, because your question
11 implies foreseeability beyond the
12 prosecution history. As I said earlier,
13 my analysis has been limited to what's in
14 the prosecution history. Somewhere I
15 discuss it that based on the prosecution
16 history it was not foreseeable. Based on
17 the prosecution history there was no IGV.
18 Whether exterior to that it was known in
19 the art, I don't have any way of knowing
20 that.

21 Q. You have not attempted to
22 determine whether the Sundstrand
23 equivalent was foreseeable to a person of
24 skill in the art at the time of the
25 amendments in light of prior art that was

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not before the examiner, correct?

A. That's correct.

Q. And do you have any basis in the case law for limiting your analysis of foreseeability to the art that was disclosed in the prosecution history?

A. I'm sorry, read that once more.

Q. Do you have any basis in the case law for limiting your analysis of foreseeability issue to art that was disclosed in the prosecution history?

A. I can't quote it to you. But I do recall seeing case law decisions essentially saying that -- it could be the InstaForm case. But, anyway, there are cases that say you are to look to the prosecution history to determine whether or not you can overcome the Festo presumption. Because, for example, Honeywell could get an affidavit from the attorney prosecuting the case and say I had no intention to do this or it was a mistake or something like that. So you are more or less forced to rely upon

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what's in the prosecution history for your
excuse. So that's why I relied only on
the prosecution history for my
determination.

Q. Specifically to the issue of
foreseeability, can you, as you sit here,
cite any case that suggests that the
analysis on the foreseeability issue
should be limited to prior art that was
disclosed within the prosecution history?

A. As I sit here, I cannot cite
you a case.

Q. You refer again in paragraph 46
to there being no indication in the file
histories that the Sundstrand equivalent
was known in the art, right?

A. Yes.

Q. And then you say "Thus, it
represents a 'later-developed technology'
that would not have been foreseeable."

Do you see that?

A. Yes.

Q. But you agree that whether or
not the Sundstrand equivalent was a

1 GARNER

2 "later-developed technology" in real life
3 might depend on what was outside the
4 prosecution history and what was known to
5 people of skill in the art outside the
6 prosecution history, correct?

7 A. That's correct.

8 Q. You also say that at the time
9 of the amendment the lockout was not known
10 to the applicant or the examiner. Do you
11 see that?

12 A. Yes, as an equivalent of the
13 change, et cetera.

14 Q. But you don't know whether at
15 the time of the amendment the so-called
16 lockout was known to others of ordinary
17 skill in the art, correct?

18 A. That's correct.

19 Q. Are you aware of anything that
20 changed in the relevant technology after
21 1982 that didn't exist before 1982 that
22 enabled Sundstrand to develop the
23 equivalent?

24 A. The only information I have on
25 that issue is that Sundstrand did develop

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don't think you have the technical basis
for this --

A. That's true.

Q. You agree you don't have the
technical basis to be making these
infringement determinations, correct?

A. Yes.

Q. Nevertheless, I suppose relying
on some of the expert reports, you have
given an opinion that the Honeywell claims
as they issued literally are broad enough
to literally cover the Sundstrand
equivalent, correct?

MS. STEVENSON: Objection to
form.

A. As I understand it and as
expressed in the report.

Q. Assuming you were right, if the
claims as issued would literally cover the
Sundstrand equivalent, then wouldn't also
those same claims with some minor
amendment also literally cover the
Sundstrand equivalent?

MS. STEVENSON: Objection.

1 GARNER

2 were.

3 Q. Are you familiar with a concept
4 in the patent law called the person of
5 ordinary skill in the art?

6 A. Yes.

7 Q. Do you agree that in the patent
8 law context the person of skill in the art
9 is presumed to have a broad universe of
10 knowledge of all of the prior art?

11 A. Yes.

12 Q. Do you agree that the knowledge
13 of the person of skill in the art in the
14 patent law context is not presumed to have
15 only the limited specific person's
16 personal knowledge?

17 MS. STEVENSON: I object to the
18 form.

19 A. Yes.

20 Q. Do you agree that the person of
21 skill in the art in the patent law context
22 is not presumed to have only the limited
23 knowledge of the applicant?

24 A. If you are talking about -- it
25 depends on how you are using a person of

GARNER

Q. Is it your understanding of the law that where the equivalents or equivalents to the equivalent were not within the prior art, that the amendment is tangential to the equivalent?

A. I wouldn't say equivalents to the equivalents, but things of the same nature. Again, it is like the Chimie case where there were two different kinds of granules or particles but the issue there was dust, whether they were dust-free or not dust-free. If you amend your claims to say that it is dust-free to get past one, that is enough like the ones that are the equivalent that the estoppel will hold.

Q. Is it your understanding of the law that where the equivalents or things like it are not within the prior art, the equivalent is tangential to the amendment?

A. Yes. Well -- yes.

Q. Did you look to see what types of -- well, strike that.

A. And by prior art, I mean prior

1 GARNER

2 art in the file history.

3 Q. Within the file history,
4 correct.

5 Describe for me an equivalent
6 to the IGV limitation that would have more
7 than a tangential relation to the reason
8 for Honeywell's amendment?

9 A. Could you read that one back.

10 Q. Describe for me an equivalent
11 to the IGV limitation that would have more
12 than a tangential relation to the reason
13 for Honeywell's amendment.

14 A. Well, if there was some prior
15 art that showed an IGV valve, say, in a
16 different context but in a control context
17 and the examiner -- say the examiner just
18 cited it. He could have just cited it or
19 he could have combined it, say, with the
20 references that he did use and make an
21 obviousness type rejection, saying here it
22 could be broader than there. The effect
23 of doing that is to put the attorney on
24 notice that IGV valve use is under
25 consideration. That puts him on notice

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submitted a new set of claims that could have been narrower than the original dependent claims or somewhere in between the original dependent claims and the original independent claims?

A. They could have done that, yes.

Q. Instead, what Honeywell chose to do was accept the examiner's offer to allow the original dependent claims in the way that they were written, correct?

A. That's correct.

Q. Now, let's go on to other reasons, which is your final area of opinion, correct? And that begins I believe on page 16; is that right?

A. Yes.

Q. In your opinion is the other reason that Honeywell should be able to overcome the presumption of surrender that a reasonable patent attorney would have believed that the asserted claims already literally covered the Sundstrand equivalent?

A. Yes.

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2 Q. Is that the only other reason
3 that you have -- that you are opining on
4 as far as why the presumption can be
5 overcome on the other reason factor?

6 A. I believe it is.

7 Q. Confirm my understanding of
8 this. Your position is that at the time
9 of the inlet guide vane amendment a
10 reasonable patent attorney in your view
11 would have known that the asserted claims
12 literally covered the Sundstrand
13 equivalent, correct?

14 A. That's not exactly it, no.

15 Q. Your opinion is that at the
16 time of the amendments a reasonable patent
17 attorney would have believed that there
18 was literal coverage already of the
19 Sundstrand product, correct?

20 MS. STEVENSON: Objection.

21 A. That's not exactly right. I
22 could explain it if you would like.

23 Q. Go ahead.

24 A. What I'm saying is that if at
25 the time of the amendment the patent

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2 have some technical expertise, correct?

3 A. Either that or have it provided
4 to you.

5 Q. So when you come up with these
6 allegations of literal infringement under
7 the scope of the original patents, you are
8 basing it on what you've read in the
9 expert reports, correct?

10 A. Primarily.

11 Q. What else?

12 A. I did have a technical question
13 and the details of it I don't recall, and
14 I asked counsel to check it with
15 Honeywell's expert to let me know whether
16 or not it was technically correct. I was
17 told that it was.

18 Q. So your technical conclusions
19 are based on the expert reports you read
20 plus some information you got from
21 Mr. Muller through Honeywell's lawyers?

22 A. Yes.

23 Q. Let's look at paragraph 56.
24 What do you know about the -- well, this
25 hypothetical reasonable patent attorney

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2 reasonable patent attorney that you've
3 created is going to be some patent
4 attorney with some degree in either
5 mechanical engineering, electrical
6 engineering, or civil engineering?

7 A. It could be physics too.

8 Q. Do you rely on any case decided
9 by any court in any jurisdiction in this
10 country for this hypothetical reasonable
11 patent attorney that you referred to a
12 dozen times in your report?

13 MS. STEVENSON: Objection.

14 Asked and answered.

15 A. No.

16 Q. Going back to 56 now, paragraph
17 56, you say "The applicant reasonably
18 believed that all uses of IGV in the
19 control of the surge valve were covered."

20 Do you see that?

21 A. Yes.

22 Q. Did you actually talk to the
23 applicant to determine or to inquire about
24 your statement there?

25 A. No. In fact, it should say